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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,926	01/18/2001	Alan John Lunn	12805-002001	9930
26161	7590	04/02/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			NGUYEN, ANTHONY H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,926

Applicant(s)

LUNN, ALAN JOHN

Examiner

Anthony H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 53-57 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 24-27, 30, 31 and 40-45 is/are rejected.
- 7) ☒ Claim(s) 16-23, 28, 29, 33-39 and 46-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 14,15,24-27, 30,31 and 40-44 are rejected under 35 U.S.C. 102(a) as being anticipated by Troester (US 6,135,022).

With respect to claims 14, 25, 30, 41 and 42, Troester teaches a marking device 10 having a housing 50 (Fig.3), a frame pivotally mounted in the housing about an axis 30, a marking head 14 which includes a head pin 12 that is actuated by a solenoid (not shown, Troester, col.10 line 13) and mounted in the carriage 15 moved parallel to the pivoted axis by a motor 28 and a motor 22 used to pivot the frame in a substantially orthogonal direction and a handle 82 (Fig.4B). Note that the elements of Troester are contained in the housing therefore the recoils of the marking head does not cause moments about the device's center of gravity.

With respect to claims 15 and 31, Troester teaches the use of a console or a controller 70, a handle 82 having a trigger 84 for operating the device as shown in Figs. 4A and 4B.

With respect to claims 24 and 40, Fig.3 of Troester shows the housing 50 having a window (no reference) through which the marking head 14 protrudes between the standoffs 48.25-27 and 42-44

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With respect to claims 26,27, 43,44, Troester teaches the head carriage 15 on which the marking head 14 is mounted for sliding along the guide rods or rails 24 and 26 or the first direction.

Claims 16, 45 and 53-55 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Wadge (US 6,263,980).

With respect to claim 45, Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the housing which is a clamshell housing. However, Wadge teaches a power tool 2 having a clamshell housing 4 that includes ribs 30 which function as a bearing bush to secure a motor 22 in place. In view of the teaching of Wadge, it would have been obvious to one of ordinary skill in the art to modify the housing of the marking device of Troester by substituting the clamshell housing as taught by Wadge for simplicity of producing a housing of a marking device. With respect to claims 16 and 53-55, the use of a motor having a rotary armature threaded on a fixed screw is well known in the art. For example, see Wadge, col.6 lines 22-29.

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Response to Arguments

Applicants' arguments filed on December 17, 2003 have been fully considered but they are not persuasive of any error in the above rejections. Applicant argues that Troester fail to teach or suggest the marking device as recited in claims 1 and 14. Specifically, applicant argues that Troester does not teach a marking device which includes a drive means to drive a pin in a third direction substantially orthogonal first and second directions against a surface to be marked.

However, as explained above, a marking device which includes a drive means which drives a head pin in a third direction for marking on a surface (Troester, col.10 line 13). Applicant's assertion about Troester's center of gravity appears to be inaccurate since all the masses of elements or parts in Troester are not taken into an account for analyzing so as to compare with applicant's center of gravity. While Troester shows two embodiments in Figs. 1 and 2 which all parts are enclosed in a housing, it appears that the marking device of Troester does not cause moments about its center of gravity which is inside the housing. Therefore, Troester meets the structure as recited in claim 14.

Applicant argues that Troester does not teach motors which are confines of the frame as recited in claim 30..

Applicant's arguments are more specific than the limitations in claim 30. For example, claim 30 line 11 requires "said motors are disposed substantially within the confines of the frame". Clearly, Troester's motors disposed substantially within the confines of the frame 28 which pivots

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about the axis 30 and the motor 22 is arranged to pivot the frame in a second “substantially orthogonal” direction as shown in Figs. 1 and 2 of Troester. Therefore, Troester anticipated the structure as recited in claim 30.

Conclusion

Claims 1-13, 56 and 57 are allowable.

Claims 17-23, 28, 29, 34-39 and 46-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

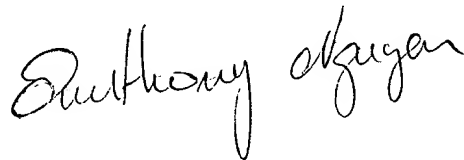
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read "Anthony Nguyen", is positioned above the typed name and title.

Anthony Nguyen
March 31, 2004
Patent Examiner
Technology Center 2800